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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/797,636 | 03/10/2004 | Bradley A. Paulson | 3136.03US02 | 4740 |
| 24113 | 7590 | 11/19/2004 | EXAMINER | |
| PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. | | | SCHILLING, RICHARD L | |
| 4800 IDS CENTER | | | ART UNIT | |
| 80 SOUTH 8TH STREET | | | PAPER NUMBER | |
| MINNEAPOLIS, MN 55402-2100 | | | 1752 | |

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,636

Applicant(s)

PAULSON ET AL.

Examiner

Richard L Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 102(a) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Camillus et al. '451. Camillus et al. '451 (see particularly paragraphs 25, 27, 28 and 54) disclose ID cards made from self-contained imaging elements comprising sealed first and second supports and intermediate imaging layers of photosensitive pressure rupturable microcapsules. Pressure or thermosensitive adhesive layers for bonding the imaging layers to the supports are disclosed. If Camillus et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use adhesive layers in the sealed microcapsule elements for securely adhering the layers together.

2. Claims 3, 4 and 7-14 are rejected under 35 U.S.C. § 102(b) as being fully met by Polykarpov et al. '520. Polykarpov et al. '520 (see particularly column 2, lines 33-67; column 3, lines 5-40; column 8, line 60 - column 9, line 55; column 10, lines 22-35) disclose self-contained, sealed microcapsule imaging elements for making ID cards wherein a magnetic recording layer is incorporated into the second support. A layer of adhesive

adheres the second support to the imaging layer. The magnetic layer is applied to the second white support film on the outer side thereof. The instant claims do not exclude the additional outer white film on the magnetic layer of Polykarpov et al.

3. Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Camillus et al. '451, Polykarpov et al. '520 and Polykarpov et al. '087. As explained in paragraph 1 above, Camillus et al. '451 discloses ID cards made from sealed microcapsule elements. Camillus et al. discloses that their ID cards may contain additional security features such as magnetic stripes but do not disclose the location of the magnetic stripes. However, Polykarpov et al. '520 discloses adding magnetic layers to the second opaque support materials of sealed microcapsule imaging elements for making ID cards; and Polykarpov et al. '087 (see particularly column 2, lines 10-20; column 3, line 50 - column 4, line 18) disclose adding magnetic layers on the backs of self-contained microcapsule elements with two sealed supports in order to store information relating to the print. Since the two Polykarpov et al. patents disclose that magnetic layers may be located on the second supports of sealed microcapsule elements including those for ID cards as in Polykarpov et al. '520, it would be obvious to one skilled in the art to locate the magnetic stripe security

feature of Camillus et al. on the second supports of the sealed microcapsule elements of Camillus et al.

4. Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Camillus et al. '451 and Anderson et al. Camillus et al. discloses ID cards made from self-contained sealed microcapsule imaging elements as explained in paragraph 1 above. Camillus et al. do not disclose the use of outer layers to prevent static. However, Anderson et al. (see particularly column 4, lines 5-20; column 9, lines 35-67) discloses self-contained elements comprising microcapsule layers sealed between two supports like the elements in Camillus et al.

Anderson et al. further teaches adding back coats to their second opaque supports of their sealed microcapsule elements to reduce static when stacked elements are moved. Therefore, it would be obvious to one skilled in the art to use outer backing layers on the second supports of the sealed microcapsule elements of Camillus et al. in order to prevent static when the elements are moved.

5. Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Camillus et al. '451, Koshizuka et al. and Bernecker. As explained in paragraph 1 above, Camillus et al. discloses ID cards of self-contained imaging elements comprising sealed first and second supports and

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intermediate imaging layers containing photosensitive microcapsules. Camillus et al. also discloses that their ID card sealed microcapsule elements may contain additional security features. Koshizuka et al. (see particularly column 1, line 5 - column 2, line 5) and Bernecker (see particularly column 4, lines 37-53; column 1, lines 8-30) disclose that ID cards may contain integrated circuit security features. Since Koshizuka et al. and Bernecker disclose that ID cards including those with photographic images may contain integrated circuits as security features, it would be obvious to one skilled in the art to use integrated circuits as additional security features in the ID cards of Camillus et al. Locating the integrated circuit on or in the second opaque supports of the elements of Camillus et al. would be obvious to one skilled in the art so that the integrated circuits do not interfere with light exposure or viewing.

6. Camillus et al. '353 is cited of interest in the art as disclosing sealed microcapsule elements.

7. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

November 16, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 4400 1752

